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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,023	03/23/2001	Joseph G. Englert	539P	8510
7590	06/16/2005		EXAMINER	
Thomas M. Freiburger 650 California Street, 25th Floor San Francisco, CA 94108				ALPERT, JAMES M
		ART UNIT	PAPER NUMBER	
		3624		

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/816,023	ENGLERT, JOSEPH G.
	Examiner	Art Unit
	James Alpert	3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 23 March 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

The application has been reviewed, and Claims 1-10 are pending. The objections and rejections are as stated below.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in both the pre-amble and the body of the claim. Without a technological basis, the claims may be interpreted, in an alternative, as involving no more than a manipulation of an abstract idea, and are therefore non-statutory under 35 U.S.C. 101. In contrast, for example, a method claim that includes in the body of the claim a structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential]. Claims 1-10 relate to a method for gathering, planning, and estimating risks and costs of financing an export transaction. However, the preamble and the body of the claims do not indicate that the claims are within the technological arts. To overcome this deficiency, claim language should be considered such that both the preamble and body of the claim indicate that they are grounded within a technological art.

***Claim Rejections - 35 USC § 112***

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps relate to Claim 1(b) in terms of subject matter for evaluation, as well as standards for evaluation as applied to the subject matter. That is to say, Claim 1(b) appears to contemplate some sort of risk evaluation, but does not describe where to find the information to be evaluated. As well, there are no standards upon which to evaluate the missing information. As such, gaps in the claims exist that need to be corrected.

In addition, Claim 1(c) is confusing. It appears that certain calculations are performed and information attained that must then be entered or written down for recording. If this is so, the calculations or retrievals should be completed initially, followed by the steps relating to what should be done with the information. This amounts to an omission of essential steps, and a gap between the steps. See MPEP § 2172.01.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al, U.S. Patent Application Publication #20020095355 in view of Francis et al, U.S. Patent #6772131.

**With regard to Claims 1,9,** Walker teaches the system and method comprising:

(a) entering onto an inquiry form:

information regarding the exporter/customer, information on the buyer in the proposed transaction, and (Paras. 66-67)

information on the goods to be sold, terms of sale and the price to be paid for the goods to be exported to the buyer, and the time frame for delivery; and also (Paras 82-84)

entering method of payment information and (Para. 98)

information concerning the financing needed for the transaction, (Para. 104)

(b) evaluating risks of the transaction, including:

risks attendant to the nature of the particular transaction and (Paras. 22-23,45,72-74,81)

to the point at which risk of loss passes to the buyer, (Paras. 78-79)

risk involved in obtaining payment to the exporter/customer, and risks attendant to financing of the entire transaction, (Paras. 81,98-99)

(c) entering information into a solution work sheet, information including

the time duration between initiation of the transaction and shipment, (Para. 100)

and the time duration from shipment until projected final payment for the goods exported, (Paras. 98-100)

incoterms for the transaction, and the time at which risk of loss passes to the buyer, (Paras. 78-79)

(c1) using a list of financial tools to review possible pre-export and post-export credit tools for financing the export transaction, (Para. 99)

Walker does not expressly teach the remaining limitations of Claim 1. However, Francis does disclose the following:

(c2) entering information on a financial tool price sheet, as to the structural cost and the transaction cost of using each of a plurality of pre-export tools listed on the list of financial tools, and a plurality of post-export tools listed on the list of financial tools, and determining lender revenue for each of the various alternatives, (Col. 6, lines 12-17)

(c3) selecting appropriate financing tools for the transaction, both pre-export and post-export, and entering projected structural costs and transaction costs on the solution work sheet as tentative costs for a course of action using the selected tools, (Col. 11, line 53 – Col. 12, line 21)

It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to modify the teachings of Walker relating to a method of analyzing an export transaction with the teaching of Francis relating to a method for inputting financial data in a working format. The motivation for such a combination is found in Walker at (Paras. 22,26,35) which describes the importance of knowing all the cost involved in an export transaction, and how to use computer technology to assist in the process.

Walker does not teach the remaining limitations, namely:

(c4) determining a total cost ratio for the financing of the transaction, calculated as total costs including structural and transaction costs, divided by the total transaction amount, the total cost ratio serving as a cost management device and a cost tracking mechanism, and

(c5) evaluating the overall cost ratio, and if it appears reasonable for the transaction, preparing a term sheet which contains a finance proposal for the export transaction.

However, the cost ratio is a statistical tool that is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to modify the teachings of Walker relating to a method of for

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analyzing an export transaction to include the cost ratio. The motivation for such a combination is found in Walker at (Paras. 22,26) which describes the importance of knowing all the cost involved in an export transaction, so as to ensure profitability. The cost ratios are critical to these determinations.

**With regard to Claim 2,** Walker teaches the method comprising:

... if the customer/exporter and a lender agree on the finance proposal, preparing an accepted finance plan, including action steps and dates and outlining the pre-export and post-export portions of the transaction and giving the lender basis for a written financing offer. (Paras. 99-100)

**With regard to Claim 3,** Walker teaches the method wherein:

wherein the step of evaluating risk of the transaction includes entry of all pertinent information on a risk evaluation sheet divided into pre-export and post-export sections. (Para. 35)

**With regard to Claim 4,** Walker does not expressly teach the method wherein:

if the total cost ratio seems unacceptable for the transaction, reiterating steps c1 through c5 using different financial tools from the list of financial tools, with entry of different costs onto the solution work sheet, in an attempt to obtain a better total cost ratio.

However, this limitation is an obvious extension over Claim 1, in that if the cost ratio calculated in Claim 1 is found to be deficiently large or otherwise problematic, the only solution is to attempt different financial tools available. This claim is rejected under the same analysis as Claims 1(c4-c5).

**With regard to Claim 5,** Walker teaches the method comprising:

including an additional step (d) of entering information on actual costs of the financing transaction as the transaction goes forward, onto a cost comparison sheet on which actual items of cost and actual total cost can be compared against costs determined in steps c2 through c5. (Paras. 108-109)

**With regard to Claim 6,** Walker does not expressly teach:

calculating an actual cost ratio and comparing the actual cost ratio to the overall cost ratio determined pursuant to step c4.

However, the cost ratio is a statistical tool that is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to modify the teachings of Walker relating to a method for analyzing an export transaction to include both theoretical and actual cost ratios. The motivation for such a combination is found in Walker at (Paras. 22,26) which describes the importance of knowing all the cost involved in an export transaction, so as to ensure profitability. The cost ratios are critical to these determinations. If anything goes peculiarly wrong, a mid-course correction can be made. See (Para. 109) as well.

**With regard to Claim 7,** Walker teaches the method further comprising:  
exporter costs with lender revenue broken out separately, and (Para. 49)  
including entry of actual costs and revenue as determined from the actual transaction cost review sheet onto an actual ratio comparison sheet, and (Paras. 108-109)  
further entering projected costs and revenue onto the actual cost ratio comparison sheet, and comparing the actual and projected costs and revenue, including comparison of actual and projected overall cost ratio for the transaction. (Paras. 108-109)

**With regard to Claim 8,** Walker teaches the method further comprising:  
evaluating performance risks of the exporter/customer, related to the payment record of the exporter/customer. (Para. 81)

**With regard to Claim 10,** Walker does not teach the system wherein:  
the cost ratio work sheet includes spaces and prompts for entry of projected lender revenue and a projected total lender revenue ratio.

However, a cost ratio work sheet including lender revenue is part of an old and well-known statistical process. It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to modify the teachings of Walker relating to a method for analyzing an export transaction to include both theoretical and actual cost ratios. Calculating lender revenue would be inherent to they system of determining the ratio. The motivation for such a combination is found in Walker at (Paras. 22,26) which describes the importance of knowing all the cost involved in an export transaction, so as to ensure profitability. The size of the lender revenue has a big impact on the overall ratio, and would influence the costs of conducting the transaction

### ***Conclusion***

The following prior art, made of record, but not relied upon, is considered pertinent to applicant's disclosure:

- a) Melchior et al, U.S. Patent Application Publication #20020099655, July 25, 2002, Facilitating Seller Financing and Advance Payment for Sellers in a Full Service Trade System.
- b) Pillay et al, U.S. Patent Application Publication #20020042763, April 11, 2002, Apparatus and Method for Providing Credit Information and/or Trade Credit Insurance Information.
- c) Tozzoli, et al, U.S. Patent #5717989, February 10, 1998, Full Service Trade System.

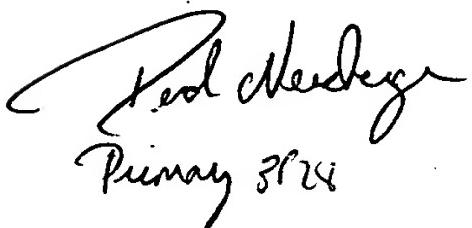
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can

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be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

  
James M. Alpert  
June 13, 2005

  
Paul Meidege  
June 13, 2005